

REMARKS

With this Response, Applicants respectfully request that claims 1, 3-6, 8-14, 16-22, and 24 be canceled without prejudice. Applicants present herein for examination new claims 25-33. Therefore, claims 25-33 are pending.

Claim Rejections - 35 U.S.C. § 103

Claims 1, 3-6, 8-14, 16-22, and 24

Claims 1, 3-6, 8-14, 16-22, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,189,146 issued to Misra et al. (*Misra*) in view of U.S. Patent No. 5,892,900 issued to Ginter et al. (*Ginter*) and U.S. Patent No. 6,269,343 issued to Pallakoff (*Pallakoff*). These claims have been canceled; therefore, rejection of these claims is moot.

New Claims 25-33

Applicants submit new claims 25-33 directed to subject matter disclosed in the specification. Applicants respectfully submit that these claims are not rendered obvious by the cited references for at least the following reasons.

New claim 25 recites:

- a network interface to obtain data associated with a volume license agreement (VLA) from a clearinghouse to transact a purchase of a software seat under the VLA in response to a user request to purchase the software;

- a database to store the obtained data, the data to include rules associated with the VLA, including rules on discount pricing, and a user profile associated with the requesting user;

- a repository to store information regarding a purchase history for the user for the software, including a number of software seats purchased under the VLA;

- a processor to access the stored VLA data, determine from the rules on discount pricing of the VLA data a discount step for the user requesting to purchase the software, determine from the stored purchase history information including the number of software seats purchased whether the discount step is current, update the discount step to reflect the determination of whether the discount price is current, and dynamically calculate a current price with the updated discount step, wherein to determine from the stored purchase history

information whether the discount step is current includes the processor to **determine if the software seat to be purchased will invoke a new discount step according to the rules on discount pricing, and if a new discount step will be invoked, determine what the new discount step will be, compare the new discount step to the discount step, and if the new discount step is different, update the discount step to be the new discount step; and** a user interface driver to receive the calculated current price and provide display information to a user interface to cause the user interface to display the current price.

Claims 28 and 31 similarly recite determining a discount step from the VLA, determining if the discount step is current including comparing an updated discount step to a discount step of stored VLA information, and dynamically calculating a current price with an updated discount step. The basis for each rejection of the old claims is discussed below with reference to these new claims.

In re Venner

The Office Action at page 7 asserts that automation of a manual process is not patentable subject matter under *In re Venner*, 120 USPQ 192 (*Venner*). The Office Action asserts that the invention fails the *Venner* test based on a comment in the Background of the invention (Specification, page 3) regarding the manual use of volume license agreements. Applicants point to another comment in the Background (Specification, page 3) that recites, "The integration of the management of VLAs with electronic commerce in a user-friendly way presents a unique set of challenges, requiring a new and novel solution."

In *Venner*, the applicants had added an automatic release mechanism that used a timing mechanism that released a mold at a fixed time, the fixed time having been determined by trial and error in the relevant art. The Court stated the principle that patentability cannot be based upon a mental step. Specifically, the Court pointed to the fact that the timing mechanism

performed no calculation of the time, the time was simply the time that had been determined previously in the art. See *Venner*, 120 USPQ at 193.

In contrast to *Venner*, the above-referenced application, as recited in claim 25 above, claims a processor to determine a discount step based on discount pricing rules in a volume license agreement (VLA) and an updateable purchase history to determine a discount step to be used to calculate a current price for a software seat. Thus, in contrast to *Venner's* timing mechanism, the claims recite a determination made based in part upon information that is dynamic, and dynamically calculating a current price.

Applicants therefore respectfully submit that the invention as recited in the currently pending claims is not merely the automation of a manual process, but provides for a patentable solution to the integration of management of VLAs and electronic commerce. Therefore, Applicants respectfully submit that rejection of new claims 25, 29, and 33 upon the basis of *Venner* would be improper.

Misra

Misra discusses a license server that receives a license pack, and distributes the licenses until all licenses are distributed. A new license pack is then obtained. See col. 2, lines 32 to 61; col. 3, line 59 to col. 4, line 30. The distributed licenses are tracked to determine which specific user has which specific license. See col. 9, lines 30 to 61; col. 11, lines 25 to 45. *Misra* fails to disclose or suggest discount steps associated with VLAs. Furthermore, the reference fails to disclose or suggest a processor to determine a discount step based on discount pricing rules in a VLA and an updateable purchase history to determine a discount step to be used to calculate a current price for a software seat. The Office Action cites *Ginter* and *Pallakoff* as disclosing a

pricing generator to generate a price in accordance with a VLA. Applicants discuss these references below.

Ginter

The Office Action cites *Ginter* as disclosing discount steps and updating discount steps. Applicants note that *Ginter* discusses allowing a purchaser to specify parts of content (i.e., articles) to purchase, and purchase of amounts of content may allow the purchaser to have a discount on images related to the selected content. See col. 22, line 26 to col. 23, line 36. *Ginter* further suggests a bitmap meter be used to monitor usage of content. See col. 24, lines 9 to 53. *Ginter* fails to disclose or suggest determining a discount step based on a history and comparing the determined discount step to a currently applied discount step, as recited in the claims.

Pallakoff

Pallakoff is cited in parallel with *Ginter* and is asserted to disclose the discount steps and updating discount steps as well as *Ginter*. *Pallakoff* discusses the use of purchasing teams to aggregate enough purchase power to qualify for discount pricing specified by a seller, and suffers from the same defects as *Ginter*. In short, *Pallakoff* fails to disclose or suggest determining a discount step based on a purchase history and comparing the determined discount step to a currently applied discount step, as recited in the claims.

Combining the References

The references, whether alone or in combination, fail to disclose or suggest every element of the claimed invention, as required by MPEP 2143 to establish a prima facie case of obviousness. *Misra* alone fails to disclose or suggest the use of a purchase history to update discount step pricing. Whether or not *Ginter* and *Pallakoff* disclose or suggest a use of purchase

history to update pricing, which Applicants do not concede, *Ginter* and *Palakoff* fail to disclose or suggest determining a discount step based on a purchase history and comparing the determined discount step to a discount step currently applied to purchase transactions by the purchaser, and therefore fail to cure the deficiencies of *Misra*. Therefore, Applicants respectfully submit that claims 25, 28, and 31 are not rendered obvious by the cited references.

Furthermore, dependent claims necessarily include the limitations of the independent claims from which they depend. Because the references fail to disclose or suggest every element of independent claims 25, 28, and 31, Applicants submit that the references fail to render obvious claims 26-27, 29-30, and 32-33, which depend from claims 25, 28, and 31, respectively.

Conclusion

For at least the foregoing reasons, Applicant submits that all rejections have been overcome. Therefore, Applicant submits that all pending claims are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to contact the undersigned by telephone if such contact would further the examination of the above-referenced application.

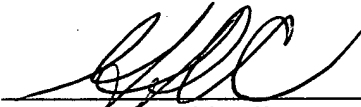
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02-2666.

Respectfully submitted,
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4/2/04



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